UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,407	02/10/2004	Steven A. Crosson Smith	BT-024	2424

			EXAMINER
29956	7590	07/28/2005	AUGUSTIN, EVENS J

TIMOTHY P. O'HAGAN
8710 KILKENNY CT
FORT MYERS, FL 33912

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	10/776,407	CROSSON SMITH, STEVEN A.
	Examiner	**Art Unit**	
	Evens Augustin	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _10 February 2004_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-18_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-18_ is/are rejected.

7)☒ Claim(s) _3,9 and 15_ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _10 February 2004_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Status of Claims

1. Claims 1-18 have been examined.

Claim Objections

Claims 3, 9, 15 are objected to under 37 CFR 1.75(c), as being of improper dependent

form for failing to further limit the subject matter of a previous claim. Applicant is required to

cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or

rewrite the claim(s) in independent form. Claims 2, 8, and 14 refer to a method of transferring

electronic funds by generating a data string for authorization response. The dummy data string

as claimed do not constitute a further limitation.

Claim Rejections - 35 USC § 112

1.   Where applicant acts as his or her own lexicographer to specifically define a term of a

claim contrary to its ordinary meaning, the written description must clearly redefine the claim

term and set forth the uncommon definition so as to put one reasonably skilled in the art on

notice that the applicant intended to so redefine that claim term. *Process Control Corp. v.*

HydReclaim Corp., 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term

"data structure " in claims 3, 9, 15 is used by the claim to mean "actual data", while the accepted

meaning is "In computer science, a **data structure** is a way of storing data in a computer so that

it can be used efficiently." The term is indefinite because the specification does not clearly

redefine the term. Therefore, data structure cannot be comprised of digital signature.

2.   An essential purpose of patent examination is to fashion claims that are precise, clear,

correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as

much as possible, during the administrative process (MPEP 2106-07, In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322) (Fed. Cir. 1989).

Claims 3, 9, 15 recite the limitation of "combine the digital signature with at least a portion of the dummy authentication data structure by replacing the dummy digital signature with the digital signature". It is unclear as to whether the applicant is referring to "replacing" or "combining" the dummy data.

Claims 4-6, 10-12 and 16-18 are also rejected as they depend on claims 3, 9 and 15.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> > (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Linehan (U.S 6327578).

As per claims 1-18, Linehan discloses an invention that includes the step of sending from a consumer's computer a start message over an Internet network to a merchant's computer. The merchant's computer then replies to the consumer's computer with a merchant message including a wallet initiation message, a merchant digital signature, and a digital certificate from an acquiring bank. The computer invention comprises of the following:

- A merchant generating an authorization request which includes containing payment amount, order description, timestamp, a random nonce, and possible additional data depending upon requirements (column 9, lines 35-40). The authorization request can also include a hash of an order description instead of the actual order description (column 16, lines 18-25) – *Claims 1, 7*

- The authorization request or hash is transferred to a remote system (column 14, lines 28-31) - *Claims 1, 7*

- Once the authorization request/hash is sent to consumer computer, the request gets sent to consumer's/issuing bank and verifies the merchant's signature to prove that the consumer is dealing with the actual merchant and validates the merchant's certificate and the acquirer's certificate (column 6, lines 8-12, column 15, lines 25-32) - *Claims 1, 7, 14*

- Sending over the Internet network an authorization token, an issuer's digital certificate, and a reference to the consumer's credit or debit card number. The authorization token includes the payment amount, order description, timestamp, a random nonce, the merchant identifier from the merchant's digital certificate, and the acquiring bank identifier from the acquiring bank's digital certificate, plus a reference to the consumer's credit or debit card number (column 25, lines 36-44) – *Claims 1, 7, 14*

- The merchant presenting the authorization code to a payment processor in order to complete the transaction (column 6, lines 48-55, column 16, lines 6-8) – *Claims 1, 7*

- The authorization includes a combination of payment amount, order description, timestamp, a random nonce, and possible additional data depending upon requirements (column 9, lines 35-40). The authorization request can also include a hash of an order

description instead of the actual order description (column 16, lines 18-25) - *Claims 2, 8,*

15

- The system can also generate dummy data (column 11, lines 3-9), in combination with

   the payment amount, order description, timestamp, a random nonce, the merchant

   identifier from the merchant's digital certificate, and the acquiring bank identifier from

   the acquiring bank's digital certificate, plus a reference to the consumer's credit or debit

   card number (column 25, lines 36-44) - *Claims 3-4, 9-10, 15-16*

- The system also used challenge-response authentication system between the remote

   computer and the server (column 7, lines 25-33) – *Claims 5-6, 11-12, 17-18*

Conclusion

4. *Examiner has pointed out particular references contained in the prior arts of record in the*

body of this action for the convenience of the applicant. Although the specified citations are

representative of the teachings in the art and are applied to the specific limitations within the

individual claim, other passages and figures may apply as well. It is respectfully requested

that if the applicant is preparing to respond, to <u>consider fully the entire references</u> as

potentially teaching all or part of the claimed invention, as well as the context of the passage

as taught by the prior arts or disclosed by the examiner.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- **Doggett et al. (US 5677955)** - An electronic instrument is created in a computer-based method for affecting a transfer of funds from an account of a payer in a funds-holding institution to a payee. The electronic instrument includes an electronic signature of the payer, digital representations of payment instructions, the identity of the payer, the identity of the payee, and the identity of the funds-holding institution

- **Wheeler et al. (US 6915430)** - The present invention generally relates to electronic communications and, in particular, to devices that generate digital signatures associated with electronic communications

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammel can be reached on 571-272-6712.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

Evens J. Augustin
July 21, 2005
Art Unit 3621